

## REMARKS

Claims 1-3, 6-11, 16, 17, 19, 21-33, 36-51 and 53 were pending and remain unchanged.

Claims 2, 6, 7, 32, 33 and 36-49 have been withdrawn from consideration.

### I. Rejection of Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 Under 35 U.S.C. § 103(a)

Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51 have been rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,105,329 to Bondoc et al. ("Bondoc") in view of U.S. Patent No. 6,305,138 to Stahl et al. ("Stahl") and U.S. Patent No. 6,421,976 to Elliott et al. ("Elliott"). Applicants respectfully traverse these rejections.<sup>1</sup>

First, the Final Office Action has acknowledged that "Bondoc does not disclose the limitations of the shadow band as claimed" (Final Office Action, page 3). The Final Office Action points to Elliott for the disclosure of the shadow band, and Stahl for the disclosure of the shadowed tips, and alleges that it would have been obvious to a skilled artisan to provide the shading features of Elliott and Stahl on the shingle of Bondoc, because "the shadings are aesthetic and provide no structural limitation to the claimed invention" (Final Office Action, p. 3-4). Applicants respectfully disagree.

Specifically, the Final Office Action alleges that Bondoc teaches the limitations of independent claims 1 and 8 because it teaches a shingle wherein at least one of the bottom outermost corners (namely, element "A" as indicated in the marked-up Figure 5 from Bondoc attached to the Final Office Action) "corresponds" to the alignment notch. The Final Office

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<sup>1</sup> Applicants note that the text of the Final Office Action, page 2, states that the claims are "anticipated" by Bondoc et al. . . . in view of Stahl . . . and Elliott." Applicants are presuming that this was an inadvertent error, and that the Examiner meant to use the term "obvious" instead of "anticipated."

Action alleges that Bondoc's "bottom outermost corner(s) correspond with the notch in that they are compatible with each other" (Final Office Action, page 3).

However, Applicants respectfully submit such an interpretation of the term "corresponds" is not correct in view of the present disclosure. The present Specification states that:

A[n] . . . embodiment of the present invention comprises a roof shingle with at least one layer having a head lap and a butt, the head lap including at least one alignment notch and the butt including at least one corner that *corresponds* to the alignment notch. *The butt edge can be curved or straight and the corners can be cropped or can be formed by right, obtuse or acute angles to correspond to the alignment notch.*

(Specification as filed, page 15, second full paragraph) (emphasis added). It is settled law that the patentee can be his own lexicographer, and in fact, Federal Circuit cases even "recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc).

In the present case, the definition of "corresponds" set forth in the Specification is consistent with that of common dictionary definitions. *See*, for example, theFreeDictionary.com, which states that "corresponds" means "identical or equivalent to" and "equivalent or parallel (mathematics)." *See also* Webster Dictionary at Webster-dictionary.net, which defines "corresponds" as "to be like something else in the dimensions and arrangement of its parts; - followed by with or to; *as, concurring figures correspond with each other throughout.*" (emphasis added)

The Specification and available dictionary definitions therefore clearly indicate that the embodiments contemplated by the inventors herein have as a feature a butt edge having corners that are identical to, equivalent to, parallel to, or are like something else in the dimensions and arrangement of its parts – that is, they *correspond to* – the alignment notch, as in a one-to-one relationship or configuration.

In contrast, Bondoc does not teach a bottom outermost corner that corresponds to the alignment notch. The term “corresponds” as recited in independent claims 1 and 8 cannot be used to describe element “A” of marked-up Figure 5 of Bondoc in the Final Office Action, because, among other reasons, the notch and the corners are not “concurring figures [that] correspond with each other throughout” as the presence of the notch destroys this “correspondence” and causes the two portions to differ. Because this element is missing from the teachings of Bondoc, and because the teachings of Stahl and Elliott do not cure this defect, claims 1 and 8 are not obvious in view of the combination of these three references.

Therefore, at least for the above-stated reasons, independent claims 1 and 8, which recite the “corresponds” limitation, are not obvious in view of the Bondoc, Elliott and Stahl references. Thus, claims 3, 9-11, 16, 17, 19, 21-31, 50 and 51 are also not obvious because they all depend either directly or indirectly from claim 1 and claim 8.

Moreover, with regard to the combination of the teachings Bondoc with those of Stahl and Elliott, the Final Action alleges that it would be obvious to modify the shingles taught by Bondoc by providing the shading patterns of Elliott and Stahl (Final Office Action, page 3). Further, it is alleged that “shadings are aesthetic and provide no structural limitation on the claimed invention” (*Id.* at pages 3-4). However, Applicants respectfully disagree.

First, it would not have been obvious to modify the shingles taught by Bondoc by providing shadings taught by Elliott and Stahl to arrive at the present invention. As discussed previously, Bondoc does not teach each and every limitation of the claims because, *inter alia*, Bondoc does not teach a shingle wherein at least one of the outermost bottom left corner and the outermost bottom right corner corresponds to the alignment notch (independent claims 1 and 8). Elliott and Stahl do not cure this defect. Even if a skilled artisan were to be motivated by the teachings of Elliott and Stahl to add a shadow band as claimed, the resultant shingle would not be described by independent claims 1 and 8.

Second, with regard to the allegation that shadings are merely aesthetic, a search of USPTO records demonstrates that the USPTO has recognized the functionality of structuring a shingle such that varied shading on different areas of a shingle provides a solely visual effect such as an appearance of, for example, thickness or foreshortening. See, for example, U.S. Patent No. 6,212,843 to Kalkanoglu et al, which was previously made of record in the present application (claim 1 directed to “granules in . . . second areas being of a **visually distinct shading**”) (emphasis added). Moreover, the Elliott and Stahl references cited in the Final Office Action are themselves directed to roofing shingles having visually distinctive patterns. For example, Elliott is entitled, “Shingle for **Optically Stimulating** a Tile Roof” (emphasis added) and claims various layers of granules having first and second “darker shading area[s]” (Elliott, claim 1), with no distinction between the composition of the “darker” shading granules and those that are not “darker.” Stahl is entitled, “Composite Shingle Having Shading Zones in Different Planes” and claims “a first lighter shading” and “a second, darker shading than said first shading” (Stahl, claim 1). Here, as in Elliott, the granules are not described as compositionally different other than their “lighter” and “darker” characteristics.

Thus, Applicants respectfully submit that providing the shadow band limitations of the present claims would not have been obvious based on the combination of the references cited, and second, is not a merely aesthetic limitation; and in fact serves as a mechanical function that makes the claims patentably distinguishable from the art.

Because claims 3, 9-11, 16, 17, 19, 21-31, 50 and 51 all depend from claim 1 or claim 8, these claims are also not obvious in view of the combination of Bondoc, Stahl and Elliott.

For at least these reasons, Applicants respectfully submit that this rejection has been overcome, and should be withdrawn.

## II. Rejection of Claim 53 Under 35 U.S.C. § 103(a)

Claim 53 has been rejected under 35 U.S.C. § 103(a) based on the teachings of Bondoc. Applicants respectfully traverse.

The Final Office Action alleges essentially that because a single shingle claimed in claim 53 would be obvious in view of the teachings of Bondoc, two shingles would also be obvious as merely a “duplication of parts” (Final Office Action, p. 11). However, one of the unique features of the invention, as embodied by claim 53 as a product-by-process claim, is that a plurality of shingles having a unique pattern can be formed by a single cutting cylinder having a circumference that is a fraction of the length of a single shingle, such that rotation of the cylinder will result in a predetermined number of singles that provides an “essentially repeating” pattern – that is, one rotation of the cylinder will produce 1.5 shingles, and 2 rotations of the cylinder will produce 3 shingles. Claim 53 is directed to the plurality of shingles that are a result of this process, and hence demonstrate this essentially repeating pattern. This is advantageous because it results in a set number of shingles with a predictably repeating pattern, and a final product that

is visually attractive to a customer in that it conveys the appearance of a thicker shingle even though thinner materials are used. Because, for the reasons stated in Section I of this Response above, each of the individual shingles is not obvious in view of the art cited, Applicants respectfully submit that claim 53 is also not obvious, as its patentability hinges on the patentability of the shingles.

Applicants are mindful that the present application has been the subject of prosecution over several years, and hereby confirm their previous oral representations to the Examiner that they will be seeking an interview with the Examiner after submission of the present Response, with a view to clarifying the issues pending and moving toward resolution of the case. Should any issues or questions remain in the meantime, the Examiner is invited to contact Applicants' attorneys at the telephone number below.

No fees, other than the fees for extension of time and the Request for Continued Examination, are believed to be due for filing the present Response. However, the Director is hereby authorized to charge any necessary fees associated with this filing or credit any overpayment to Deposit Account No. 03-1250, Reference No. 12080001.000019, Customer No. 43,309.

Respectfully submitted,

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